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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,027	01/22/2002	Raymond Wells	AMSP51552	8685

466 7590 09/24/2003

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ARLINGTON, VA 22202

EXAMINER
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KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

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DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/000,027	WELLS, RAYMOND	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-18 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other:  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-27-03 has been entered.

***Claim Rejections - 35 USC § 112***

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "readily detachable means for guiding the heel of the user's foot as the user inserts the foot into a shoe" is indefinite because the element(s) or step(s) is/are not defined in the specification by corresponding structure, material or acts and equivalents thereof, see 35 USC 112, sixth paragraph, and therefore it is not clear what is meant by that language. Therefore, the examiner is unable to determine what structure or equivalent structure is encompassed by such language. It is clear from applicant's remarks that he is invoking 35 USC 112, 6<sup>th</sup> paragraph and applicant refers to the specification for a determination of equivalent thereof. However, the examiner is unable to determine such structure from the specification. Applicant refers to page 8, lines 24-32 but both applicants' remarks and the specification is silent with

regard to "readily detachable means". Moreover, there is no listing of corresponding equivalent structure. Since there is no corresponding structure, etc. in the specification to define the means or step plus function limitation, an equivalent will be deemed to be any element that is capable of performing the specified function. . "[Sixth paragraph of 35 U.S.C. 112] was intended to permit the use of means expressions without recitation of all the possible means that might be used in a claimed apparatus. The price that must be paid for use of the convenience is limitation of the claim to the means specified in the written description and equivalents thereof." O.I. Corp. v. Tekmar Co., 42 USPQ2d 17777, 1782 (Fed. Cir. 1997).

If applicant wishes to properly invoke 35 U.S.C., 6<sup>th</sup> paragraph, applicant must:

- Show why the claim language properly invokes 35 U.S.C. 112, 6<sup>th</sup>
- Identify the function
- Amend the specification to **explicitly** state what structure corresponds to the recited function with reference to the claimed terms and phrases, provided no new matter is introduced. (e.g. means for fastening includes one of the following equivalent structures: hook and loop type fastener, a buckle fastener, a snap fastener and a button fastener)

The PTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See Donaldson, 16 F.3d at 1194, 29 USPQ2d at 1850. In the event that it is unclear whether the claim limitation falls within the scope of 35 U.S.C. 112, sixth paragraph, a rejection under 35 U.S.C. 112, second paragraph may be appropriate. Since there is no corresponding structure, etc.

in the specification to define the means or step plus function limitation, an equivalent will be deemed to be any element that is capable of performing the specified function.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US 4503628 (Mancinelli).

Mancinelli teaches a shoe insert (10) for a shoe as claimed including equivalent readily detachable means for guiding the heel of the user's foot (the back portion of the shoe insert has a contour of the back portion of the shoe and hence has a contour of a back portion of a user's heel; Moreover, see lines 16-26 of the abstract) as the user inserts the foot into the shoe, and having a being crimped over the back rim of the shoe (best shown in figure 2) and at least one fastener (self-adhesive strips 30) for securing the attachment to the shoe. The shoe insert (10) is a shoehorn inasmuch as it functions as aids to facilitate slipping the heel of the foot into the shoe, see the abstract.

The insert is made out of a substantially rigid but somewhat flexible plastic material, as is applicant and the insert has a back portion and side portions. The insert is also flexible so that it can conform and be used in various types of shoes, see col. 1,

lines 54-66 and col. 4, lines 5-10. Therefore inasmuch as it has all of the structure as claimed it satisfies the functional language. See page 6, the last full paragraph of applicant's remarks to what he alleges the means language is to be construed as. The insert of Mancinelli satisfies this means plus function language.

### ***Response to Arguments***

5. Applicant's arguments filed Sept 5, 2003 have been fully considered but they are not persuasive.

Applicant argues the shoe insert of Mancinelli doesn't teach means for guiding as claimed.

To the contrary, as best understood, the back of the shoe insert has a contour that corresponds to the back of the heel and since the insert facilitates sliding the heel of the foot into the shoe it appears to have equivalent structure as claimed.

Applicant argues "the flange of MANCINELLI et al. does not protrude substantially above the rim and thus is not an equivalent to the claimed means."

The flange of Mancinelli doesn't protrude substantially above the rim. However, this is not claimed and therefore is moot. See applicant's remarks on page 6, the last full paragraph to what he thinks the means language is claiming. Nowhere is it mentioned about the rim protruding substantially above the rim. This just appears to add more confusion to the means plus function language applicant is using in claim 1, hence the 35 USC 112, 2<sup>nd</sup> paragraph rejection being applied.

Applicant argues, "MANCINELLI et al. do not perform the recited function of guiding the heel of a user's foot as the user inserts the foot into the shoe".

To the contrary, see col. 1, lines 38-46, "An object of the present invention is to provide a shoe insert...of a U-shaped configuration to conform with the heel engaging surface...to stiffen and reinforce the quarter portion.... and facilitate insertion of a wearer's foot into the shoe".

6. Claims 7-18 are allowable

### ***Conclusion***

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc.,

Art Unit: 3728

requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
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Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
September 17, 2003